

THIS OPINION IS NOT A
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Mailed: February 2, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Center For Excellence In Higher Education, Inc.

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Serial No. 88893908
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Erik M. Pelton of Erik M. Pelton & Associates, PLLC,
for Center For Excellence In Higher Education, Inc.

James Stein, Trademark Examining Attorney, Law Office 107
J. Leslie Bishop, Managing Attorney.

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Before Goodman, Larkin and Allard,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Center For Excellence In Higher Education, Inc. (“Applicant”) seeks registration on the Principal Register of the mark ONLINE BUT NEVER ALONE. (in standard characters) for

educational services, namely, providing online learning instruction at the college and post-secondary educational levels, in International Class 41.¹

¹ Application Serial No. 88893908 was filed on April 29, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as April 27, 2020.

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that Applicant's mark, as used in connection with the services set out above, so resembles the registered mark ONLINE. BUT NOT ALONE. in standard characters (with a disclaimer of the term ONLINE) for the following services:

Educational services, namely, providing accredited and certified courses of instruction at the post-secondary and college level and distributing course materials in connection therewith, in Class 41,²

as to be likely to cause confusion, to cause mistake, or to deceive.

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. The appeal is fully briefed.

We affirm the refusal to register.

I. Analysis

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each

² The cited registration issued on August 1, 2017 (Reg. No. 5,256,902). The cited registration also covers goods in Classes 9 and 16. The description of goods in each class is set out in detail in connection with Applicant's arguments thereto.

DuPont factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *In re Chatam Int’l*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); see also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods [or services].’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity of the Services

With regard to the similarity of the services, we must make our determination based on the services as identified in Applicant’s application and the cited registration. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comp. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods [or

services], the particular channels of trade or the class of purchasers to which sales of goods [or services] are directed.”).

Applicant did not address the second and third *DuPont* factors in its brief, thus “[a]pparently conceding the issue,” *In re Morinaga Nyugyo K. K.*, 120 USPQ2d 1738, 1740 (TTAB 2016), “so we offer only a brief explanation of our conclusion.” *Id.* Applicant’s services are “educational services, namely, providing online learning instruction at the college and post-secondary educational levels”. The services identified in the cited registration are “[e]ducational services, namely, providing accredited and certified courses of instruction at the post-secondary and college level and distributing course materials in connection therewith.” Those broadly identified services of “providing accredited and certified courses of instruction at the post-secondary and college level” encompass the more narrowly identified services of “providing online learning instruction at the college and post-secondary educational levels.” Indeed, the cited mark specifically references providing the identified services “ONLINE.” As a result, the services are legally identical. *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at * 3 (TTAB 2020).

“Thus, the second *DuPont* factor strongly favors a finding of likelihood of confusion.” *Id.*

B. Similarity of Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because Applicant’s and Registrant’s services are legally identical, we must presume that these services travel through the same channels of trade and are

offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

Accordingly, the third *DuPont* factor also weighs heavily in favor of finding a likelihood of confusion.

C. Strength or Weakness of the Cited Mark

Because the strength or weakness of the cited mark informs our comparison of the marks, we address Applicant's arguments that the cited mark is weak and entitled to a narrow scope of protection.³

In determining the strength of the cited mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

³ Applicant's brief, p. 9 (6 TTABVUE 10).

1. Inherent Strength

The cited mark issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). Therefore, we assume that it is inherently distinctive and at least suggestive. *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, “we must assume that it is at least suggestive”). But we may find that a presumptively distinctive registered mark “is nevertheless weak as a source indicator” in the course of a *DuPont* analysis. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517-18 (TTAB 2016).

Applicant argues that the mark of the cited registration has diminished source-identifying significance because the terms “ONLINE” and “BUT NOT ALONE” are highly suggestive of the services offered under it.⁴ Applicant argues that Registrant’s mark informs the consumer where it will be conducting its services (ONLINE), and submitted evidence that, due to the overwhelming popularity of online education as a result of the need to physically and socially distance during the Covid-19 pandemic, education administrators recognize the need to help students avoid the feeling of isolation when learning online, and that the terms NOT ALONE or BUT NOT ALONE are commonly associated with this sentiment.⁵ Consequently, according to Applicant, Registrant’s mark suggests that the services offered thereunder will include a way for students learning remotely to connect with others or that others are

⁴ Applicant’s brief, p. 13-14 (6 TTABVUE 14-15); Applicant’s Reply brief, p. 4 (9 TTABVUE 5).

⁵ Exhibits A-F, attached to the Nov. 11, 2020 Response to Office Action at TSDR 21-47.

present in the online lesson so that the on-line student is not isolated. We agree. In the context of higher education services offered online, we find that the mark in the cited registration is highly suggestive.

As for marketplace strength, there is no evidence regarding the mark's commercial strength, as is typical with ex parte appeals in which the owner of the cited registration is not a party.

2. Commercial Weakness

Applicant argues that the record demonstrates that Registrant's mark in its entirety or components thereof, such as NOT ALONE or BUT NOT ALONE, are commonly used in commerce by third parties on goods and services sufficiently related to those described in the cited registration to render the mark of the cited registration relatively weak. In support of its position that Registrant's mark is commercially weak, Applicant made of record evidence of third-party use of what it claims is at least sixteen (16) other marks for "educational programs" that are "extremely similar or identical" to the registered mark.⁶ The following evidence made of record by Applicant is most probative:

- Exhibit G – shows use of "Online, But Not Alone: 2-Day Residency," allows the school's online MBA students an opportunity to participate on campus to create real-world connections;⁷
- Exhibit H – shows use of "Online, But Not Alone" to describe the online computer programming school's community of students who support each other on the school's online platform;⁸

⁶ Applicant's brief, p. 10 (6 TTABVUE 11).

⁷ Nov. 11, 2020 at TSDR at 50.

⁸ *Id.* at 53.

- Exhibit I – shows use of “100% Online, But Not Alone” to describe the school’s online B.A. and certificate programs supported by professors and staff;⁹
- Exhibit J – shows use of “Online But Not Alone” in describing that online students are supported while obtaining their degrees online;¹⁰ and
- Exhibit L – “Online, Not Alone” used with the University of Louisville’s video program describing the school’s online student enrollment support.¹¹

These third-party uses, as discussed in more detail below, are relevant to assessing the commercial weakness of the cited mark.

However, Applicant also made of record the following third-party use evidence that is less probative:

- Exhibit K – “Learn Online, Not Alone” used with a resource site for parents who are assisting with their child’s online schooling;¹²
- Exhibit M – “Apart But Not Alone” with a mental health resource site;¹³
- Exhibit N – “You’re Not Alone” with a mental health resource site;¹⁴
- Exhibit O – “You Are Not Alone” with an online parent support site;¹⁵
- Exhibit P – “Home But Not Alone!” for online programming offered by the City of Coronado to its citizens that were traditionally offered in person at city facilities, such as the library, prior to the pandemic;¹⁶
- Exhibit Q – “You Are Not Alone.” used with a mental health resource app;¹⁷

⁹ *Id.* at 58.

¹⁰ *Id.* at 61.

¹¹ *Id.* at 68.

¹² *Id.* at 66.

¹³ *Id.* at 70.

¹⁴ *Id.* at 74.

¹⁵ *Id.* at 79.

¹⁶ *Id.* at 89.

¹⁷ *Id.* at 92.

- Exhibit R – “You Are Not Alone” for the title of a religious retreat for pastors, lay leaders, chaplains and spiritual caregivers;¹⁸
- Exhibit T – “Not Alone” for a conference on a variety of social and religious topics, such as grief, congregation/church healing from “church drama”, addiction recovery, ministering to the mental health needs of first responders, etc.;¹⁹
- Exhibit U – “Not Alone” for an online workshops that promotes fun and play;²⁰ and
- Exhibit V – “Home But Not Alone” for a program promoting Catholic lifestyle at home.²¹

Applicant argues that the above third-party uses are relevant because the marks are used with “educational programs,”²² which are related to Registrant’s “various downloadable and non-downloadable publications, teaching materials, school supplies, newsletters, and educational services in Classes 9, 16 and 41.”²³ Apart from

¹⁸ *Id.* at 97.

¹⁹ *Id.* at 103-110.

²⁰ *Id.* at 112.

²¹ *Id.* at 115.

²² Applicant’s brief, p. 10 (6 TTABVUE 11).

²³ Applicant’s Reply brief, p. 7 (9 TTABVUE 8). The cited registration contains the following descriptions of goods in International Classes 09 and 16:

Downloadable electronic publications, namely, instructional teaching and training manuals, reference books, workbooks, textbooks, catalogs, manuscripts, classroom and independent study guides, pamphlets, leaflets, directories, calendars, brochures, charts, fact sheets, practice sheets and folios relating to post-secondary and college level accredited and certified courses of instruction; electronic publications, namely, instructional teaching and training manuals, reference books, workbooks, textbooks, catalogs, manuscripts, classroom and independent study guides, pamphlets, leaflets, directories, calendars, brochures, charts, fact sheets, practice sheets and folios relating to post-secondary and college level accredited and certified courses of instruction recorded on computer media, in International Class 09; and

Printed matter, namely, instructional teaching and training manuals, reference books, workbooks, textbooks, catalogs, manuscripts, classroom and independent study guides, pamphlets, leaflets, directories, calendars, brochures, charts, fact sheets, practice sheets and

these general conclusions and attorney arguments, which are “no substitute for evidence,” *In re Embiid*, 2021 USPQ2d 577, at *40 (TTAB 2021), Applicant did not make of record any evidence to support its arguments or otherwise persuasively or sufficiently explain why the above third-party uses are related to, for example, the downloadable and nondownloadable publications, teaching materials, and “[e]ducational services, namely providing accredited and certified courses of instruction at the post-secondary and college level”.²⁴ Further, the above-recited uses are not equivalent, comparable or tantamount to instruction at the post-secondary and college level, but rather more akin to a “one-off” opportunity to engage in a topic of personal interest. Therefore, we find that the services described above, such as mental health services and religious counseling services, are sufficiently different from the goods and services covered under the cited registration that these third party uses have little probative value for the purpose of assessing the commercial weakness of the cited mark. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) (“[T]he controlling inquiry [under the sixth *DuPont* factor] is the extent of third-party marks in use on

folios relating to post-secondary and college level accredited and certified courses of instruction; notebooks, appointment books, appointment cards, note cards, occasion cards, post cards, calendars, folders, stationery, notepads, telephone and address directories, pocket and desk diaries, theme books, scrap books, book covers, pen and pencil holders, pens, pencils, binders, loose-leaf binders, printed newsletters, printed periodicals, printed brochures, event programs, bumper stickers, decals, decorative stickers, and stickers, all relating to post-secondary and college level accredited and certified courses of instruction; printed newsletters, printed periodicals, and printed brochures relating to post-secondary and college level accredited and certified courses of instruction, in International Class 16.

²⁴ *Id.* at p. 7 (9 TTABVUE 8).

“similar” goods or services.”). *Cf. i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration).

Turning back to the third-party evidence that is deemed relevant to the issue of commercial strength, we find that there are five (5) probative third-party uses. The third-party use evidence here “reflects a more modest amount of evidence than that found convincing in *Jack Wolfskin [Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.]*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015)] and *Juice Generation, [Inc. v. GS Enters. LLC]*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015)] wherein ‘a considerable number of third parties’ use [of] similar marks was shown.”²⁵ *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1674 (finding that 10 third-party uses and a dictionary definition of the involved term supported a finding “that the shared phrase SMOKIN’ (SMOKING) HOT is somewhat weak”) (quoting *Juice Generation*, 115 USPQ2d at 1674). As a result, we find that Applicant has not established that the cited mark is commercially weak. *i.am.symbolic*, 123 USPQ2d at 1751 (evidence of third-party use “falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in [applicant’s] cited cases”).

To summarize, we find that the record supports a finding that the cited mark is highly suggestive of the services offered thereunder. However, the evidence does not

²⁵ “[I]n *Juice Generation*, there were at least twenty-six relevant third party uses or registrations of record, see 115 USPQ2d at 1672 n.1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n.2.” *Morinaga*, 120 USPQ2d at 1746 n.8.

support a finding that the cited mark is commercially weak. Rather, we find that the scope of protection of the registered mark is somewhat less than the normal scope of protection to which inherently distinctive marks are entitled. *See Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347-48 (TTAB 2017) (Board found that the opposer's marks were inherently distinctive and entitled to "the normal scope of protection to which inherently distinctive marks are entitled" where the evidence was insufficient "to establish that the terms either have a descriptive significance or are in such widespread use that consumers have come to distinguish marks containing them based on minute differences."). Further, we note that even weak marks are entitled to protection against confusion. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) ("[E]ven suggestive or weak marks are entitled to protection from the use of a very similar mark for legally identical services.").

D. Similarity of the Applicant's and Registrant's Marks

We next consider the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. Sept. 13, 2019)).

"The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression

such that persons who encounter the marks would be likely to assume a connection between the parties.” *i.am.symbolic*, 123 USPQ2d at 1748 (quoting *Coach Servs. Inc.*, 101 USPQ2d at 1721 (internal quotation marks omitted)). The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018). Because the services at issue include “educational services, namely, providing online learning instruction at the college and post-secondary educational levels,” the average purchaser is an ordinary consumer who is considering enrolling in college or obtaining some other post-secondary education.

Where, as here, the Applicant’s services and the services recited in the cited registration are legally identical, the degree of similarity between the marks necessary to find a likelihood of confusion declines. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

Applicant’s mark is ONLINE BUT NEVER ALONE. in standard characters and the cited mark is ONLINE. BUT NOT ALONE. also in standard characters. The marks are nearly identical in sight because they share the terms ONLINE BUT and ALONE, as well as the “period” at the end of each mark, all of which appear in the respective marks in the same order. The marks differ by Applicant’s use of the term NEVER, where Registrant uses the term NOT, and Registrant’s use of a “period” after the term ONLINE. The similarities far outweigh the differences, and consequently the marks are highly visually similar.

There is no evidence in the record supporting any differences in cadence in the pronunciation of Applicant's and Registrant's marks due to the presence of the period after the term "ONLINE" in Registrant's mark in written form. The period after ONLINE in the cited mark could easily be ignored by consumers, leaving both marks to be pronounced and heard essentially the same, particularly where someone with a "general rather than specific" recollection of how the cited mark is pronounced separately hears Applicant's mark. *i.am.symbolic*, 127 USPQ2d at 1630. We find that the differences between the marks when pronounced are relatively minor; overall, the marks sound very similar when pronounced.

With respect to connotation and commercial impression, the evidence of record shows that NEVER means "not ever."²⁶ We agree with the Examining Attorney that the difference between the marks in the use of NOT versus NEVER is merely a matter of degree,²⁷ and the use of NEVER in Applicant's mark does little to create a substantive distinction between them. In short, the marks have very similar meanings.

Applicant argues that the marks create different commercial impressions. Applicant argues that the Registrant's mark conveys the commercial impression that "the student of Registrant's online school services and materials are not 'ALONE'

²⁶ Nov. 11, 2020 Response to Office Action at TSDR 139.

The Examining Attorney requests that we take judicial notice of the dictionary definition of the word "never". 8 TTABVUE 9. However, it is unnecessary to do so, as Applicant previously made the definition of record. Exhibit Y to the Nov. 11, 2020 Response to Office Action at TSDR 139 ("Never" means "not ever").

²⁷ 8 TTABVUE 13.

while they are attending lectures and courses.”²⁸ In contrast, Applicant argues that its mark “creates a more nebulously supportive commercial impression through its use of the unshared word ‘NEVER[]’”²⁹ and that, as a result, “no matter what [the student] is going through or what decisions they make when continuing their schooling online, they will ‘NEVER’ be left to do it alone.”³⁰ We disagree. Because the Applicant’s and Registrant’s marks contain nearly identical words in the same order, and mean nearly the same thing, differing only as a matter of degree, we find that the marks make very similar commercial impressions in light of the identical services offered under them. That is, when considered in their entirety, both marks engender the impression that a student taking online classes is not learning in isolation but will instead have a community of support.

Therefore, we find that the Applicant’s mark is very similar to Registrant’s mark. This *DuPont* factor weighs in favor of a likelihood of confusion.

II. Conclusion

In sum, we find that Applicant’s services are legally identical to the services described in the cited registration, the channels of trade and classes of purchasers are considered to be the same, and the marks are very similar, particularly taking into account the lessened degree of similarity that is required for confusion to be likely because the marks are used in connection with legally identical services. These

²⁸ Applicant’s brief, p. 15 (6 TTABVUE 16).

²⁹ *Id.* at p. 16 (6 TTABVUE 17).

³⁰ *Id.*

Serial No. 88893908

factors outweigh any conceptual weakness of the cited mark. Therefore, confusion between the Applicant's mark and the mark of the cited registration is likely.

III. Decision

The refusal to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), is affirmed.